

REMARKS/ARGUMENTS

Amendments

The claims are modified in the amendment. More specifically, claims 1, 12, and 20 have been amended. Therefore, claims 1-10, 12-18 and 20-22 remain present for examination. No new matter is added by these amendments. Applicant respectfully requests reconsideration of this application as amended.

35 U.S.C. §103 Rejection, Rosen in view of Kolling et al.

The Office Action has rejected claims 1-10, 12-18 and 20-22 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of U.S. Patent No. 5,557,518 to Rosen (hereinafter "Rosen") in view of the cited portions of U.S. Patent No. 5,920,847 to Kolling et al. (hereinafter "Kolling"). The patent office (the "Office") is charged with putting forth a *prima facie* showing of obviousness. Applicants believe a *prima facie* case of obviousness has not been properly set forth in the final Office Action or, in the alternative, the current amendments render the present rejections moot. The basic test for obviousness is excerpted below:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.” MPEP §2143, Original Eighth Edition, August, 2001, Latest Revision May 2004.

Applicants believe the rejection has flaws with all three prongs of the above test for establishing a *prima facie* case of obviousness as outlined below.

Teachings Missing from the Cited References

With regard to the third prong of the test, Applicants believe Rosen and Kolling do not, either alone or in combination, teach or suggest the invention in the claims. More specifically, (1) Neither Rosen nor Kolling provides a third account, where the third account is not associated with either the first party or the second party, is a temporary stored value fund, and receives credits from the first account and debits from the second account; (2) Rosen does not imply that there is notification of a first transfer clearing by a process that can initiate the second transfer; and (2) Kolling does not teach or suggest doing a second transfer before determining that the first one clears. For least these reasons, Applicants respectfully request for reconsideration of the rejection to the claims.

First Missing Limitation: The Third Account

All claims require provision of a third account. The third account is not associated with either the first party or the second party, is a temporary stored value fund, and receives credits from the first account and debits from the second account. Neither Rosen nor Kolling provide a similar third account. Rosen provides two (2) money modules that store and transfer money. See Rosen, Fig. 1, col. 4, lines 14-16 ("*The money modules contemplated herein are tamper-proof devices capable of storing and transferring electronic money.*") (*emphasis added*). Rosen does not provide a single account. Further, The money modules are associated with a party. See Rosen, col. 4, lines 25-27 ("Conceptually, a trusted agent is a surrogate actor for an entity who wants to transact remotely (electronically) in a secure way."). As such, Rosen simply does not describe a third account.

Kolling does not overcome the deficiencies found in Rosen. Kolling provides several accounts related to the parties. See Kolling, Fig. 6, col. 18, line 63 -- col. 19, line 5 ("Settlement Bank 128 is shown with four accounts: a settlement account 154 for Bank C, a settlement account 155 for Bank B, a settlement account 152 for the payment network, and a settlement account 156 representing settlement accounts for other banks besides Bank C and

Bank B. Settlement bank 128 is shown coupled to settlement subsystem 104 to accept transfer orders 130, which would then result in transfers of funds between accounts 152, 154, 155 and other accounts for other banks 156."). Kolling does not describe a single third account not associated with the parties. As such, Kolling also does not describe the third account.

Second Missing Limitation: First Transfer Clearance Notification

All claims require notification by the third account that the first transfer has cleared. This limitation is not expressed in Rosen, and the Office Action further illustrates this assertion. The Examiner has stated that the first party receives confirmation only of when the bill is paid. This paid bill confirmation is different from the confirmation that the first transfer is completed. A bill is paid in the second transfer and not the first transfer. Indeed, the Examiner has even stated that confirmation of transfers to the biller are rare or never happen. As such, the Examiner appears to recognize that neither Rosen nor Kolling include receiving notification, from the third account, that the first transfer has cleared.

Third Missing Limitation: Second Transfer Before Notification

All claims require initiation of the second transfer before receiving notification that the first transfer has cleared. The Office Action cites the Background Section of Kolling for this proposition, specifically, column 2, lines 26-29. Applicant disagrees. Kolling doesn't mention receiving notification of clearance between a series of transfers. Indeed, Kolling states that funds are secured before the second transfer. Kolling, column 7, lines 53-59 ("Assuming that service bureau S has correctly identified and confirmed that biller B is a biller which consumer C desired to pay with bill pay order 56, then service bureau S passes the funds to biller B as biller payment 60 (arrow 12) *after securing funds to cover the remittance.*") (*emphasis added*). Kolling simply does not describe initiating the second transfer occurs before receiving notification that the first transfer has cleared.

Motivation to Combine

Motive to Combine: Specific Mix-and-Match Motives Lacking

Applicants believe motivation for the specific combination of elements in the cited references is lacking. The Office cites a motivation to make payments as the reason to pick and choose elements from two references. Both references achieve this goal in different ways. Accordingly, it is not clear how that motive would cause one of ordinary skill in the art to start substitutions. Both references achieve this goal on their own so mixing-and-matching makes no sense. A motivation to make the specific substitutions set forth in the Office Action is respectfully requested.

Motive to Combine: Kolling Teaches Away from Combination

Applicants believe motivation for the specific combination of elements in the cited references fails because Kolling indicates that the cited examples are not suitable for electronic invoice payments. Kolling, column 10, lines 63-67. The claims state that this invention is "for transferring funds in an online transaction". This statement in Kolling refers to the example that was cited in the Office Action. One of ordinary skill in the art would be unlikely to combine a teaching from Kolling that cannot "accommodate electronic invoice presentments" as would be required in any "online transaction."

Further, Examiner merely states in the Office Action that there "is no unique motivation for bill service providers which is any different that the millions of motivations which have already occurred." The Examiner is required to state a motivation as to why one of ordinary skill in the art could have combined the elements as claimed. See MPEP § 2143.01. Providing some general assertion of motivation does not provide a reasoning for why one skilled in the art would combine the stated claim elements.

Interview Request

Should further action be required before allowance of this application, Applicant hereby requests an interview. The subject matter of this application is complex and discussing

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the issues before further action would be helpful in any further prosecution. The undersigned can be reached by telephone at 303-405-1480.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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